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**REMARKS**

Claims 31, 33, 35, 37, 39, and 40 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bouvier *et al.* (U.S. Patent No. 6,430,276). Claims 31, 35, and 39 stand rejected under 35 U.S.C § 102(e) as being anticipated by Gurfein, *et al.* (U.S. Pub. No. 2003/0081744). Claims 32 and 36 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier *et al.* (U.S. Patent No. 6,430,276) in view of Moser *et al.* (U.S. Patent No. 6,556,127). Claims 34, 38, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier *et al.* (U.S. Patent No. 6,430,276) in view of Kawahara, *et al.* (U.S. Pub. No. 2002/0184096). Bouvier does not anticipate claims 31, 33, 35, 37, 39 and 40 as claimed in the present application. The combination of Bouvier and Moser and the combination of Bouvier and Kawahara cannot establish a prima facie case of obviousness. Claims 31-41 are therefore patententable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 31-41.

**Claim Rejections – 35 U.S.C. §102 Over Bouvier**

Claims 31, 33, 35, 37, 39, and 40 stand rejected under 35 U.S.C § 102(e) as being anticipated by Bouvier (U.S. Patent No. 6,430,276). To anticipate claims 31, 33, 35, 37, 39, and 40 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Bouvier must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Bouvier must enable Applicants' claims. Bouvier does not meet either requirement and therefore does not anticipate Applicants' claims.

**Bouvier Does Not Disclose Each and Every Element of  
Claims 31, 33, 35, 37, 39, and 40**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Bouvier does not disclose each and every element of claim 31. Independent

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claim 31 claims "a method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." Independent claim 31 claims specifying telephone services for a particular caller. In stark contrast, Bouvier discloses selecting a dialup access service provider for the caller. See Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Selecting a dialup access service is not specifying telephone services as claimed in independent claim 31. In fact, the rejection admits that Bouvier does not specify telephone services for a particular caller, but instead relies on the theory of inherency to support the rejection. The Office Action dated October 20, 2004, states at page 3:

Bouvier further teaches specifying a selection of services from among a plurality of services that are offered for the call request according to the customer profile (col. 6, lines 11-16). (Note: each particular customer has subscribed a list of access service providers and each profile includes the list. Therefore, it is inherent that a selection of services from among a plurality of services are offered for a call request according to each particular customer profile.)

The rejection relies on the theory of inherency to argue that selecting an access service provider for a dialup network connection inherently selects telephone services. The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The rejection does not demonstrate why selecting an access service provider for a dialup network connection necessarily results in selecting telephone services. In fact, such inherency does not exist. Selecting an access service provider for a dialup network connection does not inherently select telephone services. Bouvier never mentions selecting telephone services and does not teach each and every element of independent claim 31. Claim 31 is patentable and should be allowed.

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Claims 33-34 depend from independent claim 31 and include all of the limitations of claim 31. Because Bouvier does not disclose each and every element of claim 31, Bouvier does not disclose each and every element of claim 33. As such, claims 33 and 34 are also patentable and should be allowed.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include "means for" and "means, recorded on [a] recording medium," for specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting an access service provider for dialup network connections not specifying telephone services for a particular caller. For the same reason that Bouvier does not disclose each and every element of claim 31, Bouvier does not disclose each and every element of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Claims 36, 37, 38, 40, and 41 depend from independent claims 35 and 39 respectively and include all of the limitations of the claims from which they depend. Because Bouvier does not teach each and every element of claims 35 and 39, Bouvier does not teach each and every element of claims 36, 37, 38, 40, and 41. As such, claims 36, 37, 38, 40, and 41 are also not anticipated by Bouvier.

Bouvier Does Not Enable  
Applicants' Claims 31, 33, 35, 37, 39, and 40

Not only must Bouvier disclose each and every element of claims 31, 33, 35, 37, 39, and 40 of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Bouvier must be an enabling disclosure of Applicants' claims 31, 33, 35, 37, 39, and 40 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own

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knowledge of the particular art and be in possession of the invention.” *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Bouvier places Applicants’ claims 31, 33, 35, 37, 39, and 40 in the possession of a person of ordinary skill in the art, Bouvier is legally insufficient to anticipate Applicants’ claims 31, 33, 35, 37, 39, and 40 under 35 USC 102(e).

Bouvier does not enable claim 31. Independent claim 31 claims specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting a dialup access service provider for the caller. See Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Selecting a dialup access service is not specifying telephone services as claimed in independent claim 31. Bouvier therefore does not place one of ordinary skill in the art in possession of claim 31 and is therefore legally insufficient to anticipate claim 31.

Claims 33-34 depend from independent claim 31 and include all of the limitations of claim 31. Because Bouvier does not place one of skill in the art in possession of claim 31, Bouvier does not place one of skill in the art in possession of claims 33 and 34. As such, claims 33 and 34 are also patentable and should be allowed.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include “means for” and “means, recorded on [a] recording medium,” for specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting an access service provider for dialup network connections not specifying telephone services for a particular caller. For the same reason that Bouvier does not place one of skill in the art in possession of claim 31, Bouvier does not place one of skill in the art in possession of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Claims 36, 37, 38, 40, and 41 depend from independent claims 35 and 39 respectively and include all of the limitations of the claims from which they depend. Because Bouvier does not place one of skill in the art in possession of claims 35 and 39, Bouvier does not

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place one of skill in the art in possession of claims 36, 37, 38, 40, and 41. As such, claims 36, 37, 38, 40, and 41 are also not anticipated by Bourvier.

Claim Rejections – 35 U.S.C. §102 Over Gurfein

Gurfein Does Not Disclose Each and Every Element of Applicants' Claims 31, 35, and 39

Claims 31, 35, and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gurfein, *et al.* (U.S. Pub. No. 2003/0081744). Gurfein does not disclose each and every element of claim 31. Independent claim 31 claims “a method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.” Independent claim 31 claims specifying telephone services for a particular caller. In stark contrast, Gurfein discloses operating a telephone entertainment program. *See* Gurfein, abstract; paragraphs 0065-0071 column 6, lines 11-16; column 8, lines 15-57. Operating a telephone entertainment program is not specifying telephone services as claimed in independent claim 31. In fact, the rejection admits that Gurfein does not specify telephone services for a particular caller, but instead relies on the theory of inherency to support the rejection. The Office Action dated October 20, 2004, states at page 3:

Gurfein further teaches specifying a selection of telephone shows (i.e. services) from among a plurality of telephone shows that are offered for the call request according to the caller profile (page 3, paragraphs 0065, 0066, 0071). (Note: each particular caller has subscribed a list of telephone shows and each profile includes the list. Therefore, it is inherent that a selection of telephone shows from among a plurality of telephone shows are offered for a call request according to each particular caller profile.)

The rejection relies on the theory of inherency to argue that selecting a telephone show inherently selects telephone services. The rejection, however, is not accompanied by the

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required analysis to support a rejection relying on inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The rejection does not demonstrate why selecting a selecting a telephone show necessarily results in selecting telephone services. In fact, such inherency does not exist. A telephone show is not a telephone service as claimed in independent claim 31. Selecting a telephone show does not inherently select telephone services. In fact, Gurfein never mentions selecting telephone services because Gurfein discloses operating a telephone entertainment program. Gurfein does not teach each and every element of independent claim 31 and therefore cannot anticipate claim 31. Claim 31 is patentable and should be allowed.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include "means for" and "means, recorded on [a] recording medium," for specifying telephone services for a particular caller. As discussed above, Gurfein discloses operating a telephone entertainment program not specifying telephone services for a particular caller. For the same reason that Gurfein does not disclose each and every element of claim 31, Gurfein does not disclose each and every element of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Gurfein Does Not Enable  
Applicants' Claims 31, 35, and 39

As discussed above, not only must Gurfein disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Gurfein must be an enabling disclosure of Applicants' claims within the meaning of *In re Hoeksema*. Independent claim 31 claims specifying telephone services for a particular caller. In stark contrast, Gurfein discloses operating a telephone entertainment program. See Gurfein, abstract; paragraphs 0065-0071 column 6, lines 11-16; column 8, lines 15-57. Operating a telephone entertainment program is not

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specifying telephone services as claimed in independent claim 31 and does not inherently result in specifying telephone services. Gurfein therefore does not place one of skill in the art in possession of independent claim 31.

Independent claims 35 and 39 recite system and computer program product claims corresponding to independent claim 31 that include "means for" and "means, recorded on [a] recording medium," for specifying telephone services for a particular caller. As discussed above, Gurfein discloses operating a telephone entertainment program not specifying telephone services for a particular caller. For the same reason that Gurfein does not place one of skill in the art in possession of claim 31, Gurfein does not place one of skill in the art in possession of claims 35 and 39. Independent claims 35 and 39 are patentable and should also be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 32 and 36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bouvier (U.S. Patent No. 6,430,276) in view of Moser, *et al.* (U.S. Patent No. 6,556,127). Claims 34, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bouvier (U.S. Patent No. 6,430,276) in view of Kawahara, *et al.* (U.S. Pub. No. 2002/0184096). To establish a *prima facie* case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Bouvier and Moser or Bouvier and Kawahara. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Bouvier and Moser or Bouvier and Kawahara. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a *prima facie* case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Bouvier and Moser or Bouvier and Kawahara must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The combination of Bouvier and Moser or Bouvier and

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Kawahara fail to meet the requirements of a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

Bouvier and Moser

The Combination Of Bouvier and Moser  
Does Not Teach all Of Applicants' Claim Limitation

To establish a prima facie case of obviousness, the proposed combination of Bouvier and Moser must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claim 32 depends from independent claim 31 and includes all of the limitations of claim 31. Claim 36 depends from independent claim 35 and includes all the limitations of claim 35. As discussed above, claims 31 and 35 claim a method and a system for specifying telephone services for a particular caller. In stark contrast, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Moser discloses speaker verification. *See* Moser, abstract, column 3, lines 57-67. Moser does not however disclose specifying telephone services for a particular caller including receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile. Because neither Bouvier nor Moser disclose each and every element of claims 32 and 36, the proposed modification cannot establish a prima facie case of obviousness. The rejection should be withdrawn and the claims should be allowed.

No Suggestion or Motivation to Combine Bouvier and Moser

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Bouvier and Moser. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Bouvier and Moser must



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come from the teaching of Bouvier or Moser, and the examiner must explicitly point to the teaching within the reference suggesting the proposed modification. Absent such a showing, the examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Bouvier discloses selecting a dialup access service provider for the caller. See Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Moser discloses speaker verification. See Moser, abstract, column 3, lines 57-67. Neither Bouvier nor Moser disclose specifying telephone services for a particular caller as claimed in claims 32 and 36. As such, there is no teaching in Bouvier or Moser to suggest the proposed combination. The combination of Bouvier and Moser therefore cannot establish a prima facie case of obviousness. Claims 32 and 36 should be allowed.

No Reasonable Expectation of Success in the  
Proposed Combination of Bouvier and Moser

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Bouvier. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Claims 32 and 36 claim a method and system for specifying telephone services for a particular caller. In stark contrast, Bouvier discloses selecting a dialup access service provider for the caller. See Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Moser discloses speaker verification. See Moser, abstract, column 3, lines 57-67. Neither Bouvier nor Moser disclose specifying telephone services for a particular caller as claimed in claim 32 and 36. The combination of Bouvier and Moser cannot together work to achieve what neither reference discloses alone. Therefore, there is no reasonable expectation of success in the combination of Bouvier and Moser. Bouvier and Moser cannot establish a prima facie case of obviousness and the rejection of claims 32 and 36 should be withdrawn.

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Bouvier and KawaharaCombination of Bouvier and Kawahara Does Not Teach or Suggest  
All of Applicants' Claim Limitations

The combination of Bouvier and Kawahara does not teach or suggest all of Applicants' claim limitations. Rejected claims 34, 38, and 41 claim a method, system and computer program product for specifying telephone services for a particular caller. As discussed above, Bouvier discloses selecting a dialup access service provider for the caller. See Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Bouvier does not disclose specifying telephone services for a particular caller. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Kawahara has nothing to do with specifying telephone services for a particular caller. The combination of Bouvier and Kawahara therefore does not disclose each and every element of claims 34, 38 and 41 and therefore cannot establish a prima facie case of obviousness. The rejection should be withdrawn.

No Suggestion or Motivation to Combine Bouvier and Kawahara

There is no suggestion or motivation to combine Bouvier and Kawahara. The suggestion or motivation to combine Bouvier and Kawahara must come from the teaching of the references themselves and the examiner must explicitly point to the teaching Bouvier and Kawahara suggesting the proposed combination. Absent such a showing, the examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaech*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The examiner has not demonstrated any teaching in either Bouvier or Kawahara suggesting their combination. The two references are unrelated and neither

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Bouvier nor Kawahara even mention specifying telephone services for a particular caller as claimed in claims 34, 38, and 41. Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Bouvier does not disclose specifying telephone services for a particular caller. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. As such, there is no suggestion or motivation to combine Bouvier and Kawahara and the proposed combination cannot support a prima facie case of obviousness. The rejection should therefore be withdrawn.

No Reasonable Expectation of Success in the Proposed Combination  
Of Bouvier and Kawahara

There is also no reasonable expectation of success in the proposed combination of Bouvier and Kawahara. As discussed above, Bouvier discloses selecting a dialup access service provider for the caller. *See* Bouvier, abstract; column 6, lines 11-16; column 8, lines 15-57. Bouvier does not disclose specifying telephone services for a particular caller. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Combining the selecting of a dialup access service provider for the caller as disclosed in Bouvier with the portable terminal device for advertising of Kawahara will not work to specify telephone services as claimed in claims 34, 38, and 41. The proposed combination of Bouvier and Kawahara therefore cannot support a prima facie case of obviousness and the rejection should be withdrawn.

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Conclusion

Claims 31, 33, 35, 37, 39, and 40 stand under 35 U.S.C § 102(e) as being anticipated by Bouvier and Gurfein. Bouvier and Gurfein do not disclose each and every element of Applicants' claims and do not enable Applicants' claims. Bouvier and Gurfein therefore do not anticipate Applicants' claims. Claims 32 34, 36, 38, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over Bouvier in view of Moser and Bouvier in view of Kawahara. The combination of Bouvier and Moser and Bouvier and Kawahara fail to meet the requirements of a prima facie case of obviousness. Applicants respectfully request reconsideration of claims 31-41.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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